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EXAMINER

TOPGYAL, GELEK W

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/663,183	<b>Applicant(s)</b> SPEASL ET AL.	
	<b>Examiner</b> GELEK TOPGYAL	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-103 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's arguments filed 9/26/2008 have been fully considered but they are not persuasive.
2. In re pages 22-29, the applicants present several arguments with respect to the plurality of independent claims. Firstly, the applicants argue that the limitations state the portability of the memory device and that the examiners have not provided a prima facie case since being "portable" is not a size limitation and that citing In re Rose, the examiner has chosen to ignore the limitations.
3. In response, the examiner respectfully disagrees. It is to be noted that the decision of In re Rose has set precedence in instances where claims recite size limitations. It is evident that by the size limitation of making the "portable" device fall within a dimension of 10.5mm, it is clear the applicants have presented a size limitation. MPEP Chapter 2100 teaches that for limitations that attempt to make changes in size/proportion, "where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device". The portability and the ability for the device to fit within a bounding box of a certain dimension does not affect the functionality of the device, for which the core functionality is to be able to connect to multiple hosts and convert image formats. Therefore, since the limitation of "the portable memory device" fitting within a bounding box of a certain dimension is met by the decision of In re Rose, the examiner has not ignored the

Furthermore, giving the broadest of interpretations, the applicants have contradicted themselves when they mention that the PC of the prior art is movable, "portable" is defined being capable of being carried or moved. Given the definition of "portable", and the applicant's admission, the PC is a portable memory device.

4. In re pages 26-27, the applicants argue with respect to claim 45 that none of the "hosts" are "physically larger than" the claimed "memory device".

5. Similarly as discussed in paragraph 3 above, limitations of being able to connect to hosts that are "larger" does not alter the core function of the device and therefore, In re Rose is still applicable to meet the claimed.

6. In re pages 27 and 28, the applicants present the argument that the Kaltenecker fails to teach the ability of determining an image file format suitable "for a second one of the hosts" and the limitation of capturing an image through a first host.

7. In response, the examiner respectfully disagrees. In col. 7, line 58 through col. 8, line 45 teaches "receiving information corresponding to the structured file and information corresponding to a file format to which information corresponding to the structured file is to be converted". The first format in Kaltenecker already exists and based on the information for the file conversion system, a new second format ("GIF, JPEG...etc) of the image is generated, which are formats that can be played on a Handheld PC 440 of Christopher.

Furthermore, the claimed "capturing" from a first host is met by the ability of Christopher to read the data from SD and Multimedia card interfaces and any other devices via connectable to the PC via the system bus 412. During the transfer process,

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the data from the first host is removed and stored onto a another medium, therefore, the images are captured from the first host and placed in the second host.

8. In re page 29, the applicants argue with respect to claim 102 that the display fills a major surface except for a border no wider than 1/16 of the size of said dimension is not for the same reasons as argue for claim 1 (paragraph 2 above).

9. Similarly as discussed in paragraph 3 above, limitations of "fitting within a bounding box of a certain dimension" and the "size of a display" does not alter the core function of the device and therefore, In re Rose is still applicable to meet the claimed. The limitation of the display filling a major surface ... than 1/16 of the size of said minor dimension is linked to the claimed "bounding box having first and second parallel surfaces separated by no more than 10.5mm", therefore, In re Rose was applied to this limitation as well. The PC 410's display is capable of performing the functions of displaying the content. Claim limitations that change the size of a display does not establish distinction in patentability.

10. In re page 29, the applicants argue that for the reasons as discussed with respect to the independent claims above, all the dependent claims are patentable.

11. As discussed in paragraphs 2-9 above, the limitations of all the independent claims are met by cited prior art and therefore the dependent claims remain rejected as well.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 1-31, 38, 40, 42, 45-67, 74-85, 89, 92-103** are rejected under 35

U.S.C. 103(a) as being unpatentable over Christopher (US 6,900,980) in view of Kaltenecker et al. (US 6,816,277).

14. **Regarding claims 1-4, 45, 49, 74-77, 92-98 and 100-103**, Christopher et al.

teaches a portable memory device comprising a substrate supporting:

- a memory (Fig. 4, Memory 414 and Storage Device 418);

- a display (Fig. 4, PC 410);

- a communications interface for establishing a user-severable communication link (Fig. 4, Communication link via cradle 420) between the memory device and a plurality of different hosts (Fig. 4, Handheld computer 440, SD card and Multimedia card 432 and other devices connectable to the PC via bus 412) at different times, at least one of the hosts being physically larger than the memory device (specifying a particular size/range of the hosts as compared to the memory device does not make the specified limitation patentably distinct. See In re Rose, 105 USPQ 237 (CCPA 1955), wherein “differences in degree and/or size and [are] not patentable distinctions” and that “the size of the article under consideration is not ordinarily a matter of invention”);

- a mounting system for rigidly attaching the memory device to each of the host at different times (Fig. 4, Cradle for coupling SD card, Multimedia card and Handheld computer 440 and via bus 412 (see col. 3, lines 5-10)); and

- a controller (Fig. 4, Processor 416) operable in response to user input to;

store in the memory an image received from a first one of the hosts via the communication link while the portable device is in communication with the first host (col. 3, lines 52-61 teaches of transferring images taken to/from any of the devices SD card 430, Multimedia card 432, Handheld computer 440 and any other devices via system bus 412 (see col. 3, lines 5-10) to/from the PC (memory 414 and 418));

render on the display an image represented in a file in the memory at least while the portable device is not in communication with any host (Fig. 4, PC has the ability to render any type of data stored/transferred thereon, including images, documents and video);

wherein the portable memory device fits within a bounding box having first and second parallel surfaces separated by no more than 10.5mm (specifying a particular size/range of the bounding box does not make the specified limitation patentably distinct. See *In re Rose*, 105 USPQ 237 (CCPA 1955), wherein “differences in degree and/or size and [are] not patentable distinctions” and that “the size of the article under consideration is not ordinarily a matter of invention”);

and communicate the image to the second host via the communication link according to the second image file format while the portable device is in communication with the second host (col. 3, lines 52-61 teaches of transferring images taken to/from any of the devices SD card 430, Multimedia card 432, Handheld computer 440 and any other devices via system bus 412 (see col. 3, lines 5-10) to/from the PC (memory 414 and 418)).

However, the system of Christopher fails to particularly teach the feature to determine a second image file format suitable for a second one of the hosts; and transform an image in the memory from a first image file format to a second image file format, and

In an analogous art, Kaltenecker et al. teaches the feature to determine a second image file format suitable for a second one of the hosts (col. 2, lines 28-61), and communicate the image to the second host via the communication link according to the second image file format while the portable device is in communication with the second host (col. 2, lines 28-61); and

transform an image in the memory from a first image file format to a second image file format (col. 2, lines 28-61);

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to determine a second format suitable for the second host and to transform the image according to the second format as taught by Kaltenecker et al. into the system of Christopher to allow for the second host to be able to view the image of the first format.

**Claims 5-9** are rejected for the same reasons as discussed in claim 1 above, and further the user operating the PC 410, a user controls the PC 410 with a keyboard, mouse or touchpad to implement the functions as discussed in claims 5-9 (see col. 4, lines 25-55).

**Regarding claims 10 and 11**, Christopher teaches the a PC 410 which has a display, however is silent to teach wherein the group consists of an LCD display,



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polymer with photoresist properties, a plasma display and an OLED display and a cholesteric display. It is noted that these display types are well known and old in the art, and therefore Official Notice is taken. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the different types of displays to increase compatibility with different types of display systems.

**Claim 12** is rejected for the same reasons as discussed in claim 1 above, wherein col. 3, lines 5-10 teaches the communication link.

**Regarding claim 13**, Christopher teaches the claimed wherein the hosts could be a PDA (met by handheld computer 10), a cellular telephone (col. 1, line 32), a TIVO device (col. 1, line 32) and a digital camera (col. 3, lines 24-26).

**Regarding claim 14**, Christopher teaches in col. 3, lines 24-26 of other storage devices that uses a memory card.

**Regarding claims 15-19, 22 and 23**, Christopher's secondary device (Figure, 4, Handheld computer 430 with the cradle 420) meets the claimed cartridge/slot for receiving the multiple memory devices with the systems ability to connect to the PC 410 via system bus 412. The connection, e.g. a USB interface has a two connectors that couple/fasten/mate the two devices that are to be connected via the connecting interface.

**Regarding claims 20-21**, Christopher teaches the claimed as discussed in col. 4, lines 25-55

**Regarding claims 24-26**, Christopher teaches the claimed in the PC 410, wherein the memory, display, communications interface and the controller are all

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attached to the substrate (PC's inherent motherboard meets the claimed substrate, which can vary in structure, i.e. flexible/rigid).

**Regarding claims 27-31**, Christopher teaches a processor (Fig. 4, processor 416), a program memory (Fig. 4, Memory 414) separate from the first memory ((Fig. 4, Storage device 418)).

**Regarding claims 38 and 40**, Christopher teaches the ability to import videos from a digital device connected to the PC 410 (see col. 3, lines 46-51) and the PC 410 has the ability to review the video files,

**Claim 42** is rejected for the same reasons as discussed in claims 10 and 11 above, and furthermore, the system of Christopher teaches a Keyboard/Mouse which meets the claimed button/receiver/switch for a remote control device.

**Claims 46-48** are rejected for the same reasons as discussed in claims 15-19, 22 and 23 above.

**Claims 50-67** are rejected for the same reasons as discussed above in claims 5-9, 12, 14, 17-22, 24, 25, 27, 28 and 31, respectively.

**Claims 78-85** are rejected for the same reasons as discussed above in claims 7, 8, 12, 13, 17, 18, 22 and 24, respectively.

**Claim 89** is rejected for the same reasons as discussed in claim 38 above.

**Claim 99** is rejected for the same reasons as discussed in claims 1 and claims 15-19, 22 and 23 above.

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15. **Claims 32, 34, 41, 68, 69, 72, 86 and 90** are rejected under 35 U.S.C. 103(a) as being unpatentable over Christopher (US 6,900,980) in view of Kaltenecker et al. (US 6,816,277) further in view of Jones et al. (US 2002/0118949).

16. **Regarding claims 32, 34 and 41**, the proposed combination of Christopher and Kaltenecker et al. teaches the claimed as discussed in claim 1, and teaches the ability to store images transferred from a digital camera (see claims 1 and 14 above), however fails to teach wherein the sequential images are rendered on the display as a movie.

In an analogous art, Jones et al. teaches the claimed in Fig. 3, steps 301-315 teaches wherein still images can be compiled into MPEG1 stream and is stored locally on the computer first before writing to the VCD. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings on Jones et al. into the proposed combination of Christopher and Kaltenecker et al to increase compatibility of systems that aren't able to reproduce a set of images.

**Claims 68, 69 and 72** are rejected for the same reasons as discussed above in claims 32, 34 and 41, respectively.

**Claims 86 and 90** are rejected for the same reasons as discussed above in claims 32 and 41, respectively.

17. **Claims 33, 35, 36, 70 and 87** are rejected under 35 U.S.C. 103(a) as being unpatentable over Christopher (US 6,900,980) in view of Kaltenecker et al. (US 6,816,277) further in view of Jeong et al. (US 6,690,878).

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18. **Regarding claims 33, 35 and 36**, the proposed combination of Christopher and Kaltenecker et al. teaches the claimed as discussed in claim 1, and teaches the ability to import videos from a digital device connected to the PC 410 (see col. 3, lines 46-51) and the PC 410 has the ability to review the video files, however, the proposed combination of Christopher and Kaltenecker et al. fails to particularly teach the feature to capture an image frame of the video file and store it as an image file in the first memory.

In an analogous art, Jeong et al. teaches in cols. 2-3 of the ability to capture a still image from a moving image stream and to input/generate file management function (image index information).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to capture a still image and to generate file management functions so that systems can use a captured still image for representing a larger movie file, especially in large databases/archives.

**Claim 70** is rejected for the same reasons as discussed in claim 35 above.

**Claim 87** is rejected for the same reasons as discussed in claim 35 above.

19. **Claims 37, 39, 43, 71 and 88** are rejected under 35 U.S.C. 103(a) as being unpatentable over Christopher (US 6,900,980) in view of Kaltenecker et al. (US 6,816,277) further in view of Torres et al. (US 6,738,075).

20. **Regarding claims 37, 39 and 43**, the proposed combination of Christopher and Kaltenecker et al. teaches the claimed as discussed in claim 1 above including the feature for a digital camera (see above claim 14) which allows for still images to be

taken, however fails to particularly teach wherein audio information (sound/associated sounds) can be associated with still images as they are rendered for display.

In an analogous art, Torres et al. (US 6,738,075) teaches in Figures 4-8, wherein audio messages (meeting the claimed "sound"/"associated sounds") can be recorded that is associated with a still image and to play the audio messages during playback of the said still images.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to store and reproduce an associated audio clip as taught in Torres et al. into the proposed combination of Christopher and Kaltenecker et al. in order to improve the ability to identify the still images taken with audible descriptions.

**Claim 71** is rejected for the same reasons as discussed in claim 37 above.

**Claim 88** is rejected for the same reasons as discussed in claim 37 above.

21. **Claim 44, 73 and 91** are rejected under 35 U.S.C. 103(a) as being unpatentable over Christopher (US 6,900,980) in view of Kaltenecker et al. (US 6,816,277) further in view of Falcon (US 7,222,207).

**Regarding claim 44**, the proposed combination of Christopher and Kaltenecker et al. teaches the claimed as discussed in claim 1 above, however fails to particularly teach the feature to determine a geolocation of the portable memory device; and render on the display a map which includes a visible marking of the geolocation.

In an analogous art, Falcon teaches in col. 9, lines 24-35 the ability to determine the current location of a portable computing device and to display that location on a map.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to display a map with the current location so that users can utilize a map for navigational purposes.

**Claim 73** is rejected for the same reasons as discussed in claim 44 above.

**Claim 91** is rejected for the same reasons as discussed in claim 44 above.

22.

### ***Conclusion***

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to GELEK TOPGYAL whose telephone number is (571)272-8891. The examiner can normally be reached on 8:30am -5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gelek Topgyal/  
Examiner, Art Unit 2621

/Thai Tran/  
Supervisory Patent Examiner, Art Unit 2621